

REMARKS

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 33 and 35-52 are still pending in this application. Claims 39, 40 and 46 have been amended to address the concerns raised in the 112, second paragraph rejection. In addition, the element of former claims 34 and 41 has been inserted into claim 33 and the dependency of claims 41, 42 and 45 have been amended.¹ No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE 35 U.S.C. 112, 2nd PARAGRAPH REJECTION HAS BEEN OVERCOME

Claims 39, 40 and 46 were rejected as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. The amendments to 39, 40 and 46 are believed to address the Examiner's concerns.

III. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

Claims 33-51 were rejected as allegedly as being obvious over Schafer et al. (US Patent No 4,424,808 - "Schafer") in view of Fabo (U.S. Patent 5,540,922) and/or Lindqvist et al. (U.S. Patent 6,051,747 - "Lindqvist"). (Applicants presume that claim 52 was also intended to be included in this rejection).

A. Schafer contains more differences to the applicants' claimed invention than is acknowledged in the Office Action

The Office Action acknowledges that Schafer fails to teach that the adhesive or coadhesive layer has an adhesion force of 0.1 – 100 N (now amended to be 1 – 100 N) and a releasable protective layer. However, Schafer failed to teach other aspects of the applicants'

claimed invention when this reference and the applicants' claimed invention is properly considered as a whole.

The Office Action asserts that it would have been inherent for the bandage of Schafer to have the applicants' claimed elasticity. However, this is unsupportable for the following reasons.

First, as previously noted, a weave comprises of a warp and a weft. Schafer refers only the warp or the weft as being "highly longitudinally elastic" (see e.g., col. 1, lines 36-43). In contrast, the applicants' claim is referring to the backing layer as having an elasticity of 20% to 150% (see applicants' claims 36-39 for narrower ranges of elasticity). Therefore, there is no direct comparison of elasticity of Schafer's warp or weft with the elasticity of the applicants' backing layer.

Second, the present rejection is based on obviousness, not anticipation. It is well known that "[o]bviousness cannot be predicated on what is not known at the time an invention is made, *even if the inherency of a certain feature is later established. In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). See **MPEP § 2112** for the requirements of rejections based on inherency." See *MPEP 2141.02, section V*. (emphasis added). As previously noted, the no extrinsic evidence has been provided in the Office Action which supports the allegation of inherency.

B. Schafer, Fabo and Lindqvist does not render the obvious the specific combination of elements represented by the applicants' claimed invention

1. Elasticity element not accounted for by combination of Schafer, Fabo and Lindqvist

As noted above, Schafer does not address the element of elasticity in the applicants' claimed invention and as neither Fabo nor Lindqvist addresses this element, the combination of Schafer, Fabo and Lindqvist do not render the applicants' claims to be obvious for this reason alone as all claim elements have not been taught or suggested.

2. No showing of finite number of identified predictable solutions

The applicants' bandage is a combination of different elements, but the nature of the bandage does not appear to be considered as a whole for determining obviousness, but rather

¹ Although the applicants believe that claim 33 was allowable and is still allowable in amended form, the applicants hold that dependent claims such as claims 46, 48 and 49 which contain the elements of claims 33, 40, 41, 42 and 45 are even further removed from being obvious over the combination of Schafer, Fabo and Lindqvist.

each element in isolation appeared to be considered, which is not the proper standard for an obviousness determination.²

It has long been held that "[i]t is *impermissible* within the framework of section 103 to *pick and choose* from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (*In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)(emphasis added))

When considering all of the possible elements which could have been selected from the combination Schafer, Fabo and Lindqvist, one of ordinary skill in the art would have been presented with virtually an infinite number of possible permutations from the collective elements and would not have led to a predictable solution.

3. Fabo and Lindqvist teach away from the combination suggested in the Office Action

The bandages of Fabo and Lindqvist are different than those of Schafer in that the former are wound dressings whereas Schafer's bandage is akin to an athletic wrap. The result is that Fabo and Lundqvist use silicone gels precisely because its adhesive strength is so poor and is less likely to adhere to the wounds (see e.g. col. 2, lines 36-51 and col. 2, lines 59-63 of Fabo).

To the extent that one of ordinary skill in the art would have been directed to use an adhesive in Schafer's bandage (the reason of which has not been established), Fabo and Lundqvist teach the use of adhesives with poor adhesive qualities which would not be within the scope of the applicants' claimed invention.

Moreover, claims 42 and 43 are directed toward a backing layer which is microbiologically nondegradable to an extent of more than 90% (or more than 99%). The reason this would even be a consideration is that the adhesive bandages owing to their elasticity and adhesiveness and can be applied for long periods of time which can lead to the problem of microbiological degradation (see paragraph [0014] of the publication of this application).

Schafer, Fabo and Linqvist neither teach not suggest the use of such a backing layer nor would there have been any reason to from the perspective of the skilled artisan as these bandages were clearly intended only for short-term use.

² The applicants note that several of the claims are now dependent on other dependent claims rather than claim 33 which further removes any assertion of obviousness against these claims which contain multiple claim elements, the

4. Optimization of Ranges argument does not show recognition of a result-effective variable

The Office Action alleges that claims 48-51 are obvious in that the described elements could be attained through routine experimentation citing *In re Aller* (and evidently relying on MPEP 2144.05, section II.A.). However, the very next section of the MPEP, section II.B., clearly states that “[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).” Nothing within Schafer, Fabo or Lindqvist makes this recognition and if the Examiner was relying on an Examiner’s Notice for this statement, the applicants request a copy of the supporting evidence which formed the basis for the Examiner’s Notice.

Closing

Schafer, Fabo and Lindqvist does not render the applicants’ claimed invention obvious because at the very least, the combined references: (1) do not teach or suggest: (a) all elements of the claimed bandage; (b) the proper combination of elements of the claimed bandage; (2) do not represent a finite number of predictable solutions; and (3) teaches away from the applicants’ bandage.

simultaneous combination of which is not taught by Schafer alone or in view of Fabo and Lindqvist.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: /Howard C. Lee/
Marilyn M. Brogan Howard C. Lee
Reg. No. 31,223 Reg. No. 48,104
Telephone: (212) 588-0800
Facsimile: (212) 588-0500